

REMARKS

Claims 1-9 stand rejected in the above-identified patent application. Claim 8 is being rewritten as new claim 10 to improve the readability and logical order of the elements of that claim. New claims 11 and 12 are being added. Thus, claims 1-11 will be pending following entry of this Amendment.

Rejection Under 35 U.S.C. §102

Claims 1-9 were rejected under 35 U.S.C. §102 as being anticipated by Aizawa, *et al.* The rejection contends that the patent describes a check valve 43 that is disposed in a drainback passage 52 of the internal combustion engine.

Claim 1 has been amended by adding a piston which is movably positioned within a cylinder in the crankcase. Thus, the check valve, introduced in the ultimate paragraph of the claim, is a separate element of the internal combustion engine. In contrast, what the Aizawa patent calls a check valve 43 is formed by the piston 13 of the engine and a vent chamber 41 that opens into the piston cylinder (column 8, lines 6-9). In certain positions of the piston within the cylinder, the piston acts as a valve by closing that opening, thereby blocking fluid flow in both directions between the vent chamber 41 and the piston cylinder. Thus, the Aizawa “check valve” is not a separate element in addition to the piston, but is actually formed by the motion of the piston within the cylinder. That is different from the check valve described and claimed in the present application as a separate element from the piston and which does not rely on piston motion to control the flow of fluid.

Furthermore, what the reference is calling a “check valve” does not correspond to the common meaning of that term within the art which meaning is used in the present application. It is well settled that claim terms take on their ordinary and accustomed

meaning unless the applicant demonstrates an intent to deviate from such meaning by redefining the term, *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 64 U.S.P.Q.2d 1812 (Fed. Cir. 2002). The standard dictionary definition of a check valve is “a valve that permits flow in one direction only”, see *Mirriam Webster’s Collegiate Dictionary - Tenth Edition*, Mirriam Webster Inc., 1994, p. 195 (copy enclosed). The so called check valve 43 in the Aizawa patent allows fluid to flow in both directions between passage 52 and the engine cylinder. Perhaps this incorrect terminology for this valve resulted from the translation of the original Japanese priority documents for the cited U.S. patent. In any case, the present applicant is entitled to have the term “check valve” interpreted by its ordinary and accustomed definition and not by contradictory and uncommon usage in another patent.

Thus, not only does the reference not teach a true check valve, its corresponding valve is not independent and distinct from the piston which is separately recited in the pending claims. As a result, the reference does not anticipate the structure of claim 1.

Furthermore, the subject matter of several dependent claims clearly is not taught in the Aizawa reference. Claim 2 recites that the check valve is a reed valve, claim 3 states that it is a check disk, and claim 4 specifies a ball valve. The reference does not use any of these components in its so-called “check valve”, which utilizes the motion of the piston to open and close the opening between the vent chamber 41 and the cylinder.

Claim 5 states that the drainback passage is formed as an integral part of the cylinder and crankcase, whereas what the rejection has identified as the drainback passage 52 in the Aizawa patent is formed by a separate tube that extends through the cylinder block 2. Along these lines, claim 6 states that the drainback passage is defined by a first

bore formed in the cylinder head and a second bore formed in the cylinder wall. That is not the case with respect to the rejection considers as the drainback passage 52 in the reference which passage 52 is defined by a separate tube rather than bores in various components of the engine.

Claim 8 has been rewritten as new claim 12. Claims 12 and 9 specify that the check valve has a check ball that seats against a bore cavity to control the flow of fluid. The use of the oscillating piston in Aizawa to control the flow of fluid not only does not anticipate this ball element, it would not be obvious to utilize a ball in place of that oscillating piston. This is especially true since unlike the ball in the bore cavity, fluid flow in the reference engine is not restricted to only one direction through the orifice being controlled by the piston.

In summary, what the Aizawa patent calls a “check valve” does not conform to the accepted definition of that type of valve because the identified element in the reference does not restrict fluid flow in only one direction. In contrast, the presently claimed element which is separate and apart from the engine piston controls the fluid flow in one direction only and thus, properly meets the definition of a check valve. As a consequence, the reference does not anticipate, nor even suggests the use of a true check valve as recited in claims 1-9.

The New Claims

Claim 10 specifies that the check valve is configured so that when the crankcase is tipped beyond a predetermined angle, the check valve prevents the flow of fluid in one direction. The subject matter of this claim is described in paragraphs [0033] and [0034] in

the pending patent application. This functionality certainly is not performed by the alleged check valve in the Aizawa, *et al.* patent which utilizes the oscillating piston to control the flow of fluid. The piston controls that fluid irrespective of the amount that the crankcase is tipped, and thus does not functionally qualify as the check valve being claimed.

Claim 11 specifies that the check valve allows and prevents the flow of fluid in the drainback passage in response to pressure in the crankcase, as described in paragraphs [0033] and [0034] of the pending patent application. Here too, the so-called check valve in the reference, which utilizes the motion of the piston to provide the valving action, does not control the flow in response to pressure in the engine crankcase. Therefore, the reference does not teach nor suggest the claimed check valve.

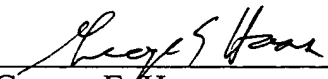
Claim 12 was discussed above with respect to the rejection of cancelled claim 8.

Conclusion

In view of these distinctions between the presently claimed engine and the Aizawa, *et al.* engine, reconsideration and allowance of the present application are requested.

Respectfully submitted,
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